



AB/3727
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17656(01172)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Q. Peter Zhang
Serial No: 09/901,315
Filed: July 9, 2001
For: LARGE BOTTLE WITH
INTEGRATED HANDLE

Exr. Mai, Tri M.
Art Unit: 3727
Confirmation No.: 7760

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

August 31, 2004

REPLY BRIEF UNDER 37 CFR §1.193(b)

Sir:

This Reply Brief is being filed, in triplicate as required under 37 CFR §1.192(a), in reply to the Examiner's Answer in this appeal, which was mailed on August 11, 2004.

The appellant would like this Honorable Board to consider the following points, which will be keyed to comments or arguments of the Examiner as follows:

1. In item (7) of the Examiner's Answer, the Examiner asserted that "appellant's brief does not include a statement that this grouping [claims 11 –16, and 20 – 21] does not stand or fall together and reasons in support thereof," citing 37 CFR §1.192(c)(7). This grouping of claims is traversed.

To begin with, appellant's Appeal Brief, on page 5, identifies claims in 7 individual groupings for consideration on appeal. Further, under the heading "ISSUES" on page 4, 4 individual issues are set forth as being the issues to be determined on appeal. This identification of the issues that are presented for review under paragraph (c)(6) of 37 CFR §1.192 entitles the groups of claims under such identified issues, at the very least, to be separately considered under paragraph (c)(8) of 37 CFR §1.192, because the claims identified in each of the 4 separate issues are separately argued under a separate heading "with citations of the authorities, statutes and parts of the record relied on." In that regard, the separate patentability of claims 11 – 16 is separately argued, over a rejection based on the Gatten reference, at pages 12 – 14 of the Appeal Brief, and the separate rejection of claims 11 – 16 over the Leary et al. reference is separately argued at pages 15 – 18 of the Appeal Brief. Further, the rejection of claims 11, 12 and 21 that is based on the Holmes reference is separately argued at pages 7 – 11 on the Appeal Brief. Thus, claims 11 – 16 "do not stand or fall together" with claims 11, 12 and 21 in the consideration of this appeal.

Likewise, claim 21, which was identified as Group VII in the grouping of claims on page 5, and was listed as Issue No. 4 on the page 4 statement of ISSUES, is separately argued on 19 – 21 of the Appeal Brief, and is entitled to be

considered separately from claims 10 and 11 in the consideration of this appeal. Further, claim 12, which was identified as the only claim in claim Group II, was separately argued for patentability from claims 11 and 21, on pages 9 and 10; claims 15 and 16, claims in claim Group V, are separately argued for patentability over claim 11 based on the Gatten rejection on pages 13 and 14, and separately argued for patentability over claim 11 based on the Leary et al. rejection on page 18.

Thus, at the very least, appellant is entitled to have this appeal considered based on the individual merits on the claims that are identified in at least some additional of the claim groupings that are identified on page 5, namely Groups I, II, V, VI and VII.

It is also to be noted that the Examiner never issued a Notice of Non-Compliance with respect to the Appeal Brief in this matter, which would have entitled appellant one month in which to file an amended brief, as required under paragraph (d) of 37 CFR §1.192. By failing to file such a Notice of Non-Compliance, it is submitted that the Examiner waived his right to contest the claim groupings proposed by Appellant on page 5 of the Appeal Brief.

2. With respect to the rejection of claims 11, 12 and 21 under 35 U.S.C. §103(a), as set forth in paragraph 1 under item 10 of the Examiner's

Answer, it is noted that the text of the rejection again makes reference to the "Kerr" reference, even though this reference is not listed with the "Prior Art of Record" under item (9) of the Examiner's answer and even though it is not referred to, with 3 of the listed references, in the basic statement of the rejection. Thus, the rejection of claim 11, 12 and 21 is clearly a 4-reference rejection and not a 3-reference rejection, and this failure to properly list and refer to the Kerr reference clearly supports the argument, at page 7 of the Appeal Brief, that the rejection of claims 11, 12 and 21 is not a proper *prima facie* obviousness rejection under In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

It is also believed that the Examiner is in error in relying on the disclosure of the dimension₄ in the Krishnakumar '105 reference in that the d₄ distance is the distance from the outside diameter of the container to the root of the handgrip portion, while the actual space between the gripping panels that is contacted by the hand of a user is determined by the distance from the diameter to the tip of the gripping feature, which is not even identified in Krishnakumar '105 let alone being mentioned. Thus, the Examiner is in error in concluding that Krishnakumar '105 teaches that the space(s) between the gripping panels of the container at issue is no more than 2-1/2 inch.

3. With respect to the rejection of claims 11 – 16 and 20, as set forth in paragraph 3 under item (10) of the Examiner's Answer, it is noted that the Examiner, in the sentence bridging page 6 and 7 of the Answer, contends that Krishnakumar '105 teaches the providing of a container "with at least 4-1/4 inch in diameter and S being at least 2-1/2 inch." This feature does not conform to the claims at issue, which requires that the space(s) between the gripping panels is no more than 2-1/2 inch. This position of the Examiner with respect to the teachings of Krishnakumar '105 on the width of dimension S is inconsistent with the position of the Examiner in the sentence preceding the sentence that bridges pages 6 and 7. In any case, as set forth in numbered paragraph 2 of this Reply Brief, it is submitted that Krishnakumar '105 contains no clear teaching as to the width between the gripping panels if such distance is measured from the tips of the recesses 36 rather than from the roots of such recesses.

4. In item (11) the Examiner contends that the Zhang Declaration is not persuasive because it interprets the Zhang Declaration as contending "that it is not obvious to use [a] PET-based cylindrical preform for [an] unduly large container because it would lead to an unacceptable appearance." This interpretation of the Zhang Declaration does not conform to the averment made by Mr. Zhang, however, where, in subparagraph a of paragraph 5, the problem

with using a PET-based material in the manufacture of a container according to Holmes is that each teaches a cylindrical body that is too wide in comparison to the width of the tapered neck portion of the container, which would result in an unduly large change in dimension in manufacturing the container from the preform. Thus, Mr. Zhang's averment, which is also similarly set forth with respect to the Gatten reference in subparagraph b, is not based solely on the width of the container, but is explicitly tied to a comparison between the width of the container and the width of the neck of the container, and the Examiner has failed to comment on this feature of the Zhang Declaration.

5. In the last paragraph on page 9, under item (11), Response to Argument, the Examiner asserts that "Applicant fails to address the limitation in Krishnakumar et al. and Slat et al. references as applied above." To begin with, the Examiner fails to identify which Krishnakumar et al. reference that this assertion applies to in that the list of references under item (9) "Prior Art of Record" includes 2 Krishnakumar et al. patents, namely 5,472,105 and 5,279,433. In any case, Applicant has addressed the limitations in Krishnakumar '105 in the Appeal Brief on page 8, in the last sentence under the first full paragraph, on page 9, in the last sentence of the paragraph that bridges pages 8 and 9, in the sentence bridging pages 9 and 10, and in the first full sentence on

page 20, and has addressed the limitation in Slat et al. in the Appeal Brief on page 8, in the second sentence of the first full paragraph and in the paragraph bridging pages 12 and 13, and in subparagraphs a and b of paragraph 5 of the Zhang Declaration.

The Examiner has also gratuitously asserted that “[o]ne cannot show nonobviousness by attacking references individually where the references are based on combination of references,” citing In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Seal, 800 F.2d 1091, 231 USPQ 375 (Fed.Cir. 1986). These cases do not control any of the matters at issue in this appeal. Keller found that a *prima facie* case of obviousness was established, based on the combination of teachings of only 3 references, namely Keller, Burkovitz and Walsh, 208 USPQ at 872, and that such a case was not overcome by the evidence of record, namely the Cywinski affidavit, 208 USPQ at 882. In the present case, however, every rejection is grounded on the combination of teachings from at least 4 prior art references, and this makes the issue as to whether or not a proper *prima facie* case of obviousness has been established an issue that is addressed in the Appeal Brief in the first full paragraph on page 7 and in the paragraph bridging pages 10 and 11, an issue that is conspicuously unmentioned in the Examiner’s Answer. Further, Merck relates to the

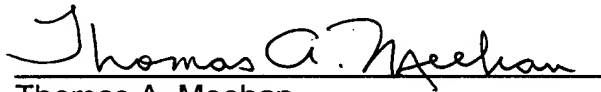
patentability of a chemical composition, namely an anti-depressant medication, and a finding of a *prima facie* obviousness was grounded on the structural similarity of the composition at issue to a prior art composition, under the principle that structural similarity, alone, may be sufficient to give rise to an expectation that compounds similar in structure will have similar properties, citing In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). 231 USPQ at 379. This is exactly the point that was made in the Appeal Brief in footnote 1 in reliance on In re Soni, 54 F.3d 746, 34 USPQ2d 1684, 1689 (Fed.Cir. 1995), that “the doctrine of *prima facie* obviousness applies most often in regard to chemical compositions, because of ‘the presumption being that similar compositions have similar properties.’ Thus, neither Keller nor Merck detract from the argument in the appeal brief that the claims at issue in this appeal cannot properly found to be *prima facie* obvious over the combination of prior art teachings that were relied on to support the rejection of such claims, and totally ignores the argument that any *prima facie* rejection, even if proper, which is not conceded, has been overcome by the Zhang Declaration.

Further, the Examiner’s answer utterly fails to set forth the applicable standards for properly combining references to support an obviousness rejection,

such as the standards set forth in Gore, Lee and Ruffit, which are cited in the Appeal Brief on page 17 thereof.

Accordingly, for any one or more of the reasons set forth in the Appeal Brief or in this Reply Brief, each of claims 11 – 16, 20 and 21 is patentable in scope under 35 U.S.C. §103(a) over the prior art references relied on in support of the various final rejections in this application, and each such final rejection should be reversed.

Respectfully submitted,


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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Date	Aug. 31, 2004

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